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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,678	01/27/2004	Mark D. Tucker	SD-7463	9818

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EXAMINER

ANTHONY, JOSEPH DAVID

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 04/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/765,678

Applicant(s)

TUCKER ET AL.

Examiner

Joseph D. Anthony

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 8-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 29 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

FINAL REJECTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-6 and 29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claims 1 and 6 contain new matter in regards to the newly added negative limitation of: "wherein said formulation does not comprise a solubilizing compound selected from the group consisting of a cationic surfactant, a cationic hydrotrope, and a fatty alcohol comprising 8-20 carbon atoms". While it is true that applicant's disclosure in the present CIP application does not require a solubilizing compound selected from the group consisting of a cationic surfactant, a cationic hydrotrope, and a fatty alcohol comprising 8-20 carbon atoms, such a lack of requirement does not provide sufficient enablement for applicant's said negative limitation of only excluding these solubilizing compounds. It must be pointed out that applicant's specification directly suggests the further addition of a solubilizing compound selected from the group consisting of a cationic surfactant, a cationic hydrotrope, and a fatty alcohol comprising 8-20

Art Unit: 1714

carbon atoms as optional components. Nowhere has applicant provided any support within the specification showing where applicants aqueous decontamination formulations must positively exclude a solubilizing compound selected from the group consisting of a cationic surfactant, a cationic hydrotrope, and a fatty alcohol comprising 8-20 carbon atoms. It is noted that applicant's claims and specification both use the modifying word "comprising" to describe the compositional nature of the claimed and disclosed aqueous decontamination formulations.

Claims 2-5 and 29 are being rejected here because they are dependent on a rejected base claim.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4, 6-7 and 29 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nakagawa et al US Patent Number 3,901,819.

Nakagawa et al. teach a composition for activating an inorganic peroxide bleaching agent comprising (A) an acetic acid ester of a monosaccharide, a disaccharide, a sugar alcohol, an internal anhydride of a sugar alcohol, or erythritol, said ester having at least 2 ester groups on the adjacent carbon atoms, and (B) an acetic acid ester of a polyhydric alcohol having a melting point not higher than about 30.degree.C., the weight ratio of the components being within the range of from 1/9 to 9/1. These are O-acetyl type bleach activators. Nakagawa et al also teaches the conventional use of low water soluble tetracetyl ethylene diamine (TAED) which is a N-acetyl type bleach activator, see abstract, column 2, lines 1-65, Tables, and claims. Applicant's claims are deemed to be anticipated over the dry composition set forth in example 3 when it is added to water. In the alternative, applicant's invention is deemed to be obvious over Nakagawa et al since it would have been obvious to add the dry

Art Unit: 1714

composition of example 3 to water since such a step is disclosed by the reference as how all the dry compositions are to be used for bleaching.

6. Claims 1-2, 4 and 29 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hardy et al. U.S. Patent Number 4,536,314.

Hardy et al teach bleach activator, bleach and detergent compositions comprising: (a) a peroxyacid bleach precursor having the general formula I "Ac—L" wherein Ac is the acyl moiety of an organic carboxylic acid comprising an optionally substituted, linear or branched C.sub.6 -C.sub.20 alkyl or alkenyl moiety or a C.sub.6 - C.sub.20 alkyl-substituted aryl moiety and L is a leaving group, the conjugate acid of which has a pKa in the range from 4 to 13, and (b) an antioxidant. The compositions combine excellent stability, substrate-safety, water-dispersibility, granulometry and detergency performance. Applicant's claims are deemed to be anticipated over Examples 22-26 when the dry compositions are added to water.

7. Claims 3 and 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hardy et al. U.S. Patent Number 4,536,314 in view of Nakagawa et al US Patent number 3,901,819.

Hardy et al differ from applicant's claimed invention in that there is no direct disclosure to the further addition of applicant's particularly claimed water-soluble bleaching activator species.

Art Unit: 1714

Nakagawa et al. teach a composition for activating an inorganic peroxide bleaching agent comprising (A) an acetic acid ester of a monosaccharide, a disaccharide, a sugar alcohol, an internal anhydride of a sugar alcohol, or erythritol, said ester having at least 2 ester groups on the adjacent carbon atoms, and (B) an acetic acid ester of a polyhydric alcohol having a melting point not higher than about 30.degree.C., the weight ratio of the components being within the range of from 1/9 to 9/1. These are O-acetyl type bleach activators. Nakagawa et al also teaches the conventional use of low water soluble tetracetyl ethylene diamine (TAED) which is a N-acetyl type bleach activator, see abstract, column 2, lines 1-29, Tables, and claims.

It would have been obvious to one having ordinary skill in the art to use the disclosure of Nakagawa et al to O-acetyl and N-acetyl bleach activators for inorganic peroxides, such as percarbonates, as motivation to actually add them as bleaching activators to the bleach formulations taught by Hardy et al for the oxidation enhancement benefits such activators would provide for the Hardy et al oxidizing reactive component and the formulations as a whole.

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakagawa et al US Patent Number 3,901,819 or Hardy et al. U.S. Patent Number 4,536,314, both said patents individually in view of Huth et al. U.S. Patent Number 6,448,062.

Both said patents have been described above except for Huth et al.. This rejection builds on the rejections made above. The primary patents both differ from

Art Unit: 1714

applicant's claimed invention in that there is no direct disclosure to the further addition of polyol drying agents such as sorbitol.

Huth et al. teach a composition for simultaneous cleaning and decontaminating a device. The composition is a per-compound oxidant in an amount effective for decontaminating the device and an enzyme in an amount effective for cleaning the device. The device may be a medical device such as an endoscope or kidney dialyzer and a plurality of devices can be cleaned using the same composition. The composition may additionally contain a corrosion inhibitor in an amount effective to prevent corrosion of a metal, a chelator, a buffer, a dye and combinations thereof, see abstract, examples and claims. Huth et al directly discloses that it is well known in the art to use polyols, such as sorbitol, as drying agents in decontamination compositions, see column 20, lines 26-41.

It would have been obvious to one having ordinary skill in the art to use the disclosure of Huth et al to polyol drying agents for decontamination formulations as motivation to actually added polyols, such as sorbitol, to the decontamination formulations taught by both primary references for the benefits that such drying agents would effect in said decontamination formulations.

Response to Arguments

9. Applicant's arguments filed 2/10/2006 with the entered amendment, and 11/14/05 with the non-entered amendment, have been fully considered but are not persuasive to

Art Unit: 1714

put the application in condition for allowance for the reasons set forth above. Additional examiner comments are set forth next.

Applicant amendment adding new matter to independent claims 1 and 6 is deemed to have overcome the previously made prior-art rejections over Tadros et al. WO 02/02192 A1 since the reference requires at least one of the excluded solubilizing agents as set forth in claims 1 and 6. Applicant's statement of common ownership by, or subject to an obligation to assign, as set forth on page 12, lines 5-15 of the REMARKS filed 11/14/05, are deemed to remove the previously applied references to Tadros et al. U.S. Patent No. 6,566,574 and Tucker et al. U.S. Patent Number 6,723,890.

Applicant's arguments for patentability over Nakagawa et al. U.S. Patent Number 3,901,819 are not well taken. The fact that Nakagawa et al.'s aqueous bleaching composition requires the present of both component (A) and (B) (wherein component (B) reads directly on applicant's claimed water-soluble bleaching activator), in no way patentably distinguishes Nakagawa et al's bleaching composition from applicant's claimed decontamination formulation for the following reasons: 1) Nakagawa et al' disclosed aqueous bleaching formulation comprise all of applicant's claimed components, 2) applicant's claims use the open claim language of "comprising" in the preambles of independent claims 1, 6 and 7 which directly open up the claims to all additional components such as Nakagawa et al's component (A), and 3) applicant's have set forth no showing of any superior and unobvious results for applicant's claimed formulations that do not require Nakagawa et al's component (A). In fact Nakagawa et al directly discloses that the present of both component (A) with component (B) greatly

Art Unit: 1714

enhances the activating effect of the activator with the peroxy bleach component. One having ordinary skill in the art would thus expect that Nakagawa et al's composition would have a superior activating effect on the peroxy compound than would applicant's claimed composition which does not require (but does not exclude) the present of Nakagawa et al's component (A).

The prior-art rejections made over the Hardy et al. patent are deemed to be valid for the reasons of record. The examiner wants to point out that applicant's water-soluble bleaching activator Markush member of: "short chain organic compounds that contain an ester bond" reads on those species of Hardy et al's O-Acyl type bleach activators that are short chained.

Finally applicant's Terminal Disclaimers have been approved by the PTO.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

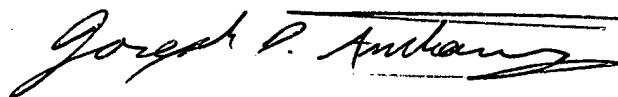
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 1714

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Examiner Information

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Joseph D. Anthony whose telephone number is (571) 272-1117. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (571) 272-1119. The centralized FAX machine number is (571) 273-8300. All other papers received by FAX will be treated as Official communications and cannot be immediately handled by the Examiner.



Joseph D. Anthony
Primary Patent Examiner
Art Unit 1714

4/4/06